

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Upon entry of the amendment presented, Claims 8-19 remain in the application. No new matter is added and no additional claims fee is believed to be due as a result of these amendments

#### **Foreign Priority Claim**

The Office Action noted that although foreign priority was claimed, a certified copy of the priority application, EP 00870158.3, had not been filed. Submitted herewith is a certified copy of said application which should resolve the priority claim.

#### **Rejection Under 35 U.S.C. § 112**

Claim 9 was rejected under 35 U.S.C. § 112, fourth paragraph, for failing to make reference to a claim earlier set forth. Claim 9 has been amended to properly depend from Claim 8 and therefore Applicants respectfully submit that this rejection has been overcome. Applicants note that the rejection also mentions Claim 1, but this is assumed to be in error. If the reference to Claim 1 was not in error, Applicants respectfully submit that the Examiner indicate the specific rejection to Claim 1.

#### **ART REJECTIONS**

##### **35 U.S.C. § 103(a) over Van Dijk in view of Sanders**

Claims 1-11 have been rejected under 35 USC §103(a) as being unpatentable over Van Dijk (WO 98/24874), in view of Sanders (U.S. Patent No. 4,264,365). The Office Action argues that it would have been obvious to combine the teachings of Van Dijk and Sanders to thereby realize the present invention. For the reasons set forth below, this rejection is respectfully traversed.

Van Dijk relates to coated detergent tablets wherein the tablets are coated with dicarboxylic acid in order to promote the appearance and/or abrasion-resistance of the tablet. Methods of coating the tablets with the dicarboxylic acid disclosed by Van Dijk include melting the coating material, applying and allowing to cool or alternatively, applying

dicarboxylic acid dissolved in water or solvent to the tablet and allowing the water or solvent to evaporate. However, Van Dijk fails to disclose a process for treating dicarboxylic acids wherein the dicarboxylic acid is heated to above its melting point and water is added.

Sanders relates to the production of pressure-sensitive carbonless record sheets utilizing a hot melt system to form a coating composition containing a chromogenic material which is set by cooling. Sanders fails to disclose any process for coating a detergent tablet or providing a dicarboxylic acid coating for a detergent tablet with reduced discoloration.

In making the rejection, the Office Action acknowledged that Van Dijk differs from the presently claimed invention in that the document “does not teach the addition of water to the molten dicarboxylic acid during the coating process, nor does it teach further process steps directly pertaining to the addition of water in the coating process.” (Paper No. 4 at Page 3).

To fill the acknowledged gap, the Office Action relies upon Sanders as teaching dioic acids with about 5 to about 10 carbon atoms, wherein although use of large amounts of solvents are avoided in the Sanders coating process, “minor amounts of such solvents can be tolerated and may even be beneficial.” (*Id.* at 4). A small amount of water in the coating composition “will act as a plasticizer and rheology modifier without requiring a solvent drying step.” (*Id.*)

The Office Action then concluded that “it would have been obvious to one of ordinary skill... to combine the teachings... into the objects of the instant application.” (*Id.*). The Office action further argues that one would be motivated to add relatively small amounts of water to the coating process of Van Dijk to incorporate the benefits of such a step (assumedly plasticizing and rheology modifying benefits) found in Sanders.

Initially, it is noted that Claim 1 as amended herein, now clearly refers to a process for providing a dicarboxylic acid coating for tablets. The rejection fails to identify where in Sanders, such a limitation can be found, as Sanders relates to coatings on “carbonless paper.” (Sanders at Col. 1, lines 30-35).

Applicants respectfully submit that the rejection uses the wrong standard for determining obviousness. The rejection relies upon hind-sight reconstruction that is not found in the statute or precedential authority. As is well settled, an Examiner cannot establish

obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would *impel* one skilled in the art to do what the patent applicant has done. The rejection fails to provide any reason why one would be motivated, let alone impelled, to combine the Van Dijk and Sanders references in the manner suggested by the Examiner. Importantly, Van Dijk relates to coated detergent tablets while Sanders relates to coated papers. The purpose of coating a detergent tablet such as that in Van Dijk or the present invention is to provide protection for the core of the tablet during shipping, handling, or manufacturing processes. Alternatively, the purpose of providing a coating on a carbonless paper image system such as that of Sanders is to provide a chemical layer for forming an image upon pressure application from a writing instrument. There is no suggestion in either Van Dijk or Sanders that the processes for coating tablets are similar to those for coating papers.

Further, neither Van Dijk or Sanders propose to solve the problem of dicarboxylic acid coating discoloration. One of ordinary skill would therefore find no motivation in either Van Dijk or Sanders to add water to the molten dicarboxylic acid coating of Van Dijk in order to improve the color of the dicarboxylic acid coating. Van Dijk provides no indication that any problem exists with the color of the dicarboxylic acid coating or that any improvement could be found by looking to the art relating to carbonless transfer paper. Similarly, Sanders provides no indication that the addition of water to molten dicarboxylic acid would be desirable for improving the color of dicarboxylic acid coatings on detergent tablets. In short, there is simply no motivation found in either Van Dijk or Sanders to combine the teachings of the two references, even if one were to assume that such combination would realize the present invention. Thus, the rejection fails to set forth the required facts and reasoning required to support a *prima facie* case of obviousness. For this reason the rejection should be withdrawn.

In addition, a *prima facie* case of obviousness, requires that the rejection describe with specificity *why* one skilled in the art would have combined two references to arrive at the claimed invention. In the present case, no such explanation is found in the rejection.

Given the foregoing considerations, it is submitted that Applicants' Claims, as amended herein, are not rendered unpatentably obvious by the teachings of Van Dijk in view of Sanders. Accordingly, a rejection over these references under 35 U.S.C. § 103(a) is

improper and should be withdrawn.

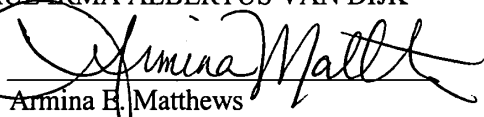


**CONCLUSION**

Applicants have made an earnest effort to place their application in proper form and to distinguish their invention from the applied prior art. WHEREFORE, Applicants respectfully request entry of the claim amendments, reconsideration of this application, withdrawal of the rejection under 35 U.S.C. §103(a), and allowance of Claims 8-30.

Respectfully submitted,  
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**Version with markings to show changes made**

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**IN THE CLAIMS:**

Claims 1- 7 were cancelled without prejudice.

Claim 9 was amended as follows:

9. (Amended) A composition according to Claim [9] 8 wherein the dicarboxylic acid is selected from C<sub>2</sub>-C<sub>13</sub> dicarboxylic acids and mixtures thereof.

New Claims 12-30 were added as outlined in the response.